

REMARKS

Claims 1, 2, and 4-10 are pending in the application. New claims 11 and 12 have been added to the application. Therefore, claims 1, 2, and 4-12 are at issue.

Claims 1 and 10 have been amended to recite that the composition is a leave-on composition in the preamble. The recitation of a leave-on composition in the body of the claims has been deleted. Claims 1 and 10 have been amended to correct an obvious typographical error in the spelling of "Acrylates." Support for this amendment can be found at page 4, line 22.

Claims 1 and 10 also have been amended to recite an average diameter for the visible particles. New claims 11 and 12 also recite an average diameter for the visible particles. Support for this amendment and new claims can be found in the specification at page 5, lines 15-17.

Claims 1 and 10 have been amended further to recite that the composition is free of a surfactant. Support for this amendment can be found throughout the specification, which fails to mention a surfactant as an essential or optional ingredient. The amendment is specifically supported in Examples 1-12, at pages 53-57 of the specification, each of which is free of a surfactant. These examples show that the inventors had possession of the presently claimed invention at the time of filing the application. Claims 1 and 10 also have been amended to overcome a rejection under 35 U.S.C. §112, second paragraph, discussed hereafter.

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hitchin U.S. Patent No. 6,106,816 ('816) in view of Karlen et al. U.S. Patent No. 6,004,545 ('545), Rath et al. U.S. Patent No. 5,993,792 ('792), and Reng et al. U.S. Patent No. 5,403,508 ('508). Claim 3 was cancelled in a previous response.

The examiner bases the rejection on the '816 patent disclosing *shampoo* compositions comprising copolymers of carboxylic acid (such as Carbopol 1342), an aqueous carrier, visible particles, viscosity modifiers, silicon compounds, propylene glycol, and cationic conditioning agents. Although the '816 patent does not teach an amphoteric conditioning polymer, a UV absorber, an optical brightener, an herbal extract, or polyethylene glycol with a molecular weight up to 1000, the examiner asserts that it would have been obvious to a person of skill in the art to add Merquat Plus 3300 to the composition of the '816 patent to achieve the beneficial effect of an amphoteric conditioner in view of the '545 patent, and to add a pearlescent dispersion comprising fatty acid glycol esters and polyethylene glycols having a molecular weight between 200 and 800 to achieve the beneficial effect of an excellent pearlescent effect in view of the '508 patent. As to the other claimed "further comprising" ingredients, the examiner asserts that it would have been obvious to one of ordinary skill to further include such compounds in the composition of the '816 patent to achieve the extra beneficial effect of these additives in view of the

'792 patent. Applicants respectfully traverse this assertion.

In order to establish a *prima facie* case of obviousness, the examiner must show that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there is a reasonable expectation of success, and (3) all of the limitations of the claims are taught or suggested in the prior art (M.P.E.P. §2143).

Applicants respectfully traverse the present obviousness rejection over the combination of the '816, '545, '792, and '508 patents. A *prima facie* case of obviousness has not been established because all of the applicants' claimed features are neither taught nor suggested, and there is no motivation to combine references.

The '816 patent discloses an aqueous shampoo composition comprising, in addition to water, a surfactant chosen from anionic, nonionic, or amphoteric surfactants, and mixtures thereof; an insoluble, nonvolatile silicone; a suspending polymer chosen from polyacrylic acid, crosslinked polymers of acrylic acid, copolymers of acrylic acid with a hydrophobic monomer, copolymers of carboxylic acid-containing monomers and acrylic esters, crosslinked copolymers of acrylic acid and acrylate esters, and heteropolysaccharide gums; and titanium dioxide-coated mica.

The surfactant is an essential component of the '816 patent composition, and if present in an

amount of less than 2%, by weight, "inadequate foaming is achieved" ('816 patent, column 2, lines 61-64). The presently claimed compositions are different from an aqueous shampoo and are free of a surfactant. The present compositions are conditioning compositions which are applied to, and allowed to remain on the hair. In contrast to the adequate foaming and rinsing required in an '816 patent composition, the presently claimed composition avoids foaming, which is detrimental to a conditioning composition. Rather than teaching or suggesting the presently claimed invention, the '816 patent leads persons skilled in the art away from the presently claimed invention.

In addition, the '816 patent discloses a composition containing titanium dioxide-coated mica particles having a particle size of 2 to 150 μm in diameter ('816 patent, column 4, lines 7-30). The present claims recite an average diameter of about 300 to about 3000 μm (claims 1 and 10) and about 300 to about 1000 μm (claims 11 and 12). The '816 patent absolutely fails to teach or suggest visible particles having the presently claimed average diameter.

In addition to the substantial differences between the presently claimed compositions and the '816 patent, the examiner admits that the '816 patent fails to teach or suggest any of five different composition ingredients, i.e., an amphoteric conditioning polymer, a UV absorber, an optical brightener, an herbal extract, or a polyethylene glycol. The examiner therefore must rely upon a string of three additional refer-

ences to account for the disclosure missing in the '816 patent.

In summary, it is submitted that claims 1, 2, and 4-12 would not have been obvious over the '816 patent. First, the '816 patent is directed to an entirely different type of composition, i.e., a hair shampoo which is rinsed from the hair, from the presently claimed composition, i.e., a hair conditioner which remains on the hair. Therefore, persons skilled in the art would not even consider the '816 patent when designing a hair conditioner. If by chance a person skilled in the art should consider the '816 patent, the reference does not contain the teachings or suggestions that provide the incentive to modify the teachings of the '816 patent and arrive at the presently claimed composition with a reasonable expectation of providing a useful *leave-on conditioning* composition. In particular, (a) the '816 patent teaches that a surfactant is an essential ingredient, whereas the present composition is free of a surfactant, (b) the '816 patent fails to teach or suggest visible particles of the size presently recited in the claims, and (c) the '816 patent fails to teach or suggest *five* other claimed ingredients.

The three additional references do not overcome the deficiencies of the '816 patent. It appears that the examiner has reviewed additional references and selectively found isolated ingredients from the different references in an attempt to reconstruct the claimed invention from hindsight.

In particular, the '545 patent is cited for teaching a copolymer of a carboxylic acid, an amphoteric conditioning polymer, water, and a silicone compound. However, like the '816 patent, the '545 patent is directed to a hair *cleaning* composition that includes a surfactant as an essential ingredient in an amount of 3 to 50 percent by weight (see abstract). The '545 patent composition also is a *rinse-off* composition.

The '792 patent also is directed to compositions containing surfactants, which as discussed above are different from the presently claimed compositions. The examiner relies upon column 2, lines 24-28 and Example 14 of the '792 patent to support the rejection. The disclosure at column 2 is merely a laundry list of twelve hair enhancers from which the examiner selectively cited enhancers that are recited in the claims. The '792 patent contains no disclosure that would have led a person skilled in the art to select the recited claim elements from the listed enhancers. The examiner also points to Example 14, which is nothing more than an aqueous solution of herbal additives, containing no additional ingredients.

The '508 patent is directed to pearlescent dispersions. The dispersion can contain a polyethylene glycol. The reference also teaches the presence of a surfactant, which is excluded from the present claims. There is no motivation from the '508 patent to selectively choose a polyethylene glycol from the numerous types and classes of compounds disclosed in the '508 patent for inclusion in the presently claimed composi-

tion. Each example of the '508 patent discloses a fatty acid glycol ester and a nonionic surfactant, neither of which are recited in the present claims and one of which is excluded from the claimed composition. No example contains a polyethylene glycol, and a polyethylene glycol is merely named in a laundry list of optional common solvents.

Additional reasons explaining why the present claims would not have been obvious over the cited references are set forth in the amendment filed June 8, 2006, incorporated herein by reference.

In summary, it is submitted claims 1, 2, and 4-10, and new claims 11 and 12, would not have been obvious over a combination of the '816, '545, '792, and '508 patents. The references, alone or in combination, fail to provide any motivation to pick and choose individual ingredients to arrive at the present invention as contended by the examiner. Accordingly, it is submitted that the rejection of claims 1, 2, and 4-10 as being obvious over the combination of cited references should be withdrawn. It also is submitted that new claims 11 and 12 are patentable over the cited references for the reasons set forth above.

In addition, the new and unexpected results achieved by the present invention were previously discussed in the amendment of June 8, 2006, and in the Sako Declaration. The unexpected benefits are attributed to the polyethylene glycol and acrylic acid/acrylate copolymers, which provides favorable esthetic benefits, conditioning benefits, such as smoothness and

softness, and leaves the hair and hands with clean feeling, are incorporated herein by reference.

Claims 1-10 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite because of the phrases "distinctively detected" and "comprised in the composition." Claims 1 and 10 have been amended to delete the term "distinctively" and the phrase "when comprised." These amendments clarify the claims, and accordingly the claims fully comply with 35 U.S.C. §112, second paragraph. Therefore, this rejection has been overcome, and should be withdrawn.

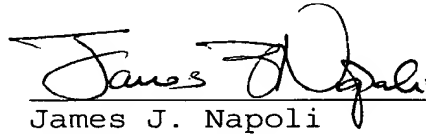
It is submitted that all pending claims are in a form and scope for allowance. An early and favorable action on the merits is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By



James J. Napoli
(Registration No. 32,361)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 474-6300

Chicago, Illinois
October 31, 2006